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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,898	07/23/2001	Yoshio Sugaya	211758US0	9196

22850 7590 12/20/2005

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EXAMINER

LIPMAN, BERNARD

ART UNIT PAPER NUMBER

1713

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/909,898

**Applicant(s)**

SUGAYA ET AL.

**Examiner**

Bernard Lipman

**Art Unit**

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005 by the Board of Appeal.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terada et al., US 5,759,373, taken with Tomoi et al., US 5,350,523, and further in view of MacDonald, US 5,045,171.

Claims are rejected for reasons as affirmed by the Board.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terada et al., US 5,759,373, taken with Tomoi et al., US 5,350,523, and further in view of MacDonald, US 5,045,171, as applied to claims 1-9, 11 and 12 above, and further in view of Akao, US 4,876,129, or Osterholtz, US 3,846,521, or Sata et al., US 4, 169,023, or Saad et al., US 6,306,646, or Chau et al., US 4,775,474.

Claim 10 is rejected for reasons as affirmed by the Board.

4. Claims 1-4, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald in view of Tomoi et al.

It would be prima facie obvious to use the precursor monomer of Tomoi (col. 5, 11. 28-45) in the method of MacDonald (col. 8, 11. 5-24 referencing col. 7, 11. 42-47) to make an anion selective membrane that has improved heat durability (Tomoi, col. 3, 11. 8-51). With respect to claim 1, it would appear that the substantially uniform structure required

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due to the "mixing substantially uniformly" limitation would be inherently present in the product resulting from the process of MacDonald because MacDonald mixes the functional monomer with the thermoplastic polymer having no ion exchange groups just as done by Applicants. The reasonableness of this conclusion lies in the identity of the process conditions used to form the claimed and prior art products and of the other shared properties of these products. Applicants are, therefore, required to prove that the subject matter shown to be in the prior art does not, in fact, possess the properties relied upon for patentability. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 432-33 (CCPA 1977).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Lipman whose telephone number is 571-272-1105. The examiner can normally be reached on 8-5 Mon-Fri.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bernard Lipman  
Primary Examiner  
Art Unit 1713

BL/hs